



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,858	02/01/1999	YOSHIROU KUROMITSU	0834-0198-3	7882

22850 7590 08/18/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/240,858

Applicant(s)

KUROMITSU ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1714

DETAILED ACTION

This office action is in response to Paper No. 17 dated June 13, 2003.

The amendment to page 3, lines 8-12, page 7, lines 2-22 and page 11, line 28 to page 12, line 11 of the specification, the cancellation of claims 1, 2 and 11-47, and the amendment to claim 3 in Paper No. 17 have been entered of record.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usui et al (Usui) 5,618,764 in view of Tose et al (Tose) 6,191,186 B1 and Ogihara et al (Ogihara) 4,299,873.

Usui teaches a ceramic composition comprising an organic vehicle selected from ethyl cellulose, an acrylic resin, a styrene resin, a phenol resin or butyral dissolved in a solvent selected from alpha terpineol, butylcarbitol acetate or phthalic acid ester combined with 60-95 % glass powder, note abstract and column 4, lines 23-31 and Example 1. Usui is silent to teachings to a plasticizer and to a dispersant and to the photosetting resin of claims 6 and self-setting resin of claims 7-8 and to the further inclusion of the degassing agent of claim 10.

Tose teaches an insulating paste comprising an organic vehicle containing a binder, a photo-polymerization initiator, column 3, lines 52-55 and a photo-setting monomer, column 3, lines 56-67 and a glass powder, column 2, lines 10-16 and further provides for the further inclusion of dispersants, defoaming agent and plasticizer, if necessary, column 4, lines 7-10.

Ogihara teaches the use of inorganic glass adhesives and the use of organic adhesives such as thermosetting resin adhesives, e.g. adhesives of epoxy resin, urea resin, melamine resin, carboxylic acid resin, with ceramic and glass powder etc., column 4, lines 1-5 and 62-65.

It would have been obvious to the artisan in the art with the teaching of Tose to further add the dispersant, plasticizer and degassing agent in the composition of the primary for their intended function because both composition are paste composition. It

Art Unit: 1714

also would have been obvious to the artisan in the art to use or substitute the photo-setting resin of Tose and the self-setting resin of Ogihara with glass and or ceramic powder for the thermosetting resin with glass and or ceramic powder of the primary reference rendering the instant claims obvious. The examiner takes the position on record that instant claim 9 reads on the requirement of only one solvent.

The prior art cited but not applied further teaches adhesive composition of the same nature as the instant claims.

Applicant's arguments filed June 13, 2003 have been fully considered but they are not persuasive.

The rejections under the second paragraph of 35 U.S.C. 12 are withdrawn in view of applicants' amendments to claim 3 and the arguments presented of record.

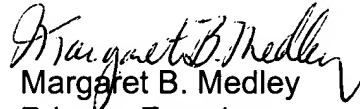
The examiner takes the position on record that instant claim 9 reads on the requirement of only one solvent as set forth in claim 3 from it depends.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday to Thursday from 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-277. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Art Unit: 1714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
Art Unit 1714

MBM
August 14, 2003